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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,853	12/20/2001	Peter Andrews	033236-0116	5475

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EXAMINER

TON, THAIAN N

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 05/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,853

Applicant(s)

ANDREWS ET AL.

Examiner

Thai-An N. Ton

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Claims 1-30 are pending and under consideration.

Note that the numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 28 been renumbered 30.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-20, 22, 24, 26 and 30 drawn to cells, cell lines and cell cultures comprising at least part of the cytoplasm derived from an embryonal teratocarcinoma cell or a cytoplasm from a teratocarcinoma cell, wherein the cell has its nucleus obtained from a differentiated somatic cell and only contains the genome of the differentiated somatic cell.

Group II, claim(s) 21, drawn to methods for inducing differentiation in a cell.

Group III, claim(s) 23 and 25, drawn to tissues or organs.

Group IV, claim(s) 27 and 29, drawn to kits comprising at least one cell according to claim 1.

Group V, claim(s) 28, drawn to methods to treat or disease or conditions requiring transplantation of tissue.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

37 CFR 1.475(c) states:

"If an application contains claims to more or less than one of the combination of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present."

37 CFR 1.475(d) also states:

"If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and 1.476(c)."

37 CFR 1.475(e) further states:

"The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternative within a single claim."

In view of 37 CFR 1.475 (c), 37 CFR 1.475 (d), and 37 CFR 1.475 (e), Group I is considered the main invention to the product (cells, cell lines and cell cultures comprising at least part of the cytoplasm derived from an embryonal teratocarcinoma cell or a cytoplast from a teratocarcinoma cell, wherein the cell has its nucleus obtained from a differentiated somatic cell and only contains the genome of the differentiated somatic cell) first mentioned in the claims.

Groups I, III and IV recite multiple distinct products that do not share the same inventive concept. The claimed invention of Groups I, III and IV recite distinct materials that are not required in the claimed invention of Group I, and thus have

their own special technical features. For example, the tissue types or organs as claimed in Group III and the kit as claimed in Group IV. Thus, it follows from the preceding analysis that the claimed inventions Group I, III and IV do not relate to a single inventive concept under PCT Rule 13.1, because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the reasons set forth above.

Additionally, Groups I-V recite distinct materials and/or methods steps that are not required for the implementation of the claimed invention of Group I, and thus, lack the same or corresponding technical feature for the following reasons:

The special technical feature of Group I is considered to be cells comprising at least part of the cytoplasm derived from an embryonal teratocarcinoma cell or a cytoplast from a teratocarcinoma cell, wherein the cell has its nucleus obtained from a differentiated somatic cell and only contains the genome of the differentiated somatic cell.

The special technical feature of Group II is considered to be the use of a cell according to claim 1 in methods for inducing differentiation.

The special technical feature of Group III is considered to be tissue types or organs comprising at least one cell according to claim 1.

The special technical feature of Group IV is considered to be a kit comprising at least one cell according to claim 1, instructions and optionally, factors required to induce differentiation of the cell.

The special technical feature of Group V is considered to be the use of a tissue type or organ according to the invention to treat conditions or diseases requiring transplantation of tissue.

Accordingly, Groups I-V do not relate to a single inventive concept under PCT Rule 13.1, because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the reasons set forth above.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1632

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thái-An N. Ton whose telephone number is (703) 305-1019. The examiner can normally be reached on Monday through Friday from 8:00 to 5:00 (Eastern Standard Time), with alternating Fridays off. Should the examiner be unavailable, inquiries should be directed to Deborah Reynolds, Supervisory Primary Examiner of Art Unit 1632, at (703) 305-4051. Any administrative or procedural questions should be directed to William Phillips, Patent Analyst, at (703) 305-3482. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 872-9306.

TNT

Thái-An N. Ton
Patent Examiner
Group 1632


DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 1800/1630